Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed September 26, 2007, and are being filed along with a REQUEST FOR CONTINUED EXAMINATION UNDER 37 C.F.R. §1.114.

I.   Summary of Examiner's Rejections

Prior to the Office Action mailed September 26, 2007, Claims 1-60 and 62-65 were pending in the Application. In the Office Action, Claims 1, 21, 40, 49, 50, 60 and 62 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

II.   Summary of Applicant's Amendment

The present Response amends Claims 1, 21, 40, 49, 50 and 60, cancels Claims 20, 39 and 62-65 and adds new Claims 66-70, leaving for the Examiner's present consideration Claims 1-19, 21-38, 40-60 and 66-70. Reconsideration of the Application, as amended, is respectfully requested. Applicant respectfully reserves the right to prosecute any originally presented or canceled claims in a continuing or future application.

III.   Claim Rejections under 35 U.S.C. § 112

In the Office Action mailed September 26, 2007, Claims 1, 21, 40, 49, 50, 60 and 62 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. More specifically, the claims were rejected as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The present Response hereby amends Claims 1, 21, 40, 49, 50 and 60, and cancels Claim 62. Support for the amended material can be found in paragraph [0023] and claims 20, 39, 40 and 49, as well as other portions of the Specification as originally filed. For example, see "A sender can utilize a petition generator to create a petition... this can happen as a result of receiving the recipient's email address." (par. [0023]) and "the email access list is used to determine whether or not email from a sender is permitted to reach the recipient" (original claim 20).

Applicant respectfully submits that as amended, Claims 1, 21, 40, 49, 50 and 60 comply with the requirements of 35 U.S.C. § 112, first paragraph, and reconsideration thereof is respectfully requested.

IV. Prior Art Rejections

Prior to the Reply filed on June 26, 2007, the claims had been rejected as being unpatentable over Andivahis (U.S. Patent No. 7,146,009) and Shirai (U.S. Patent No. 6,466,968). In the following remarks, Applicant respectfully traverses these previous rejections regarding the claims as they are currently amended.

Claim 1

As amended, Claim 1 defines:

1.   *A computer implemented method for modifying a list of permitted senders used by electronic mail (email) access control devices, said method comprising:*

under control of a sender:

accepting a recipient identifier;

providing sender information along with a petition provider identifier to a recipient, the recipient having an access list of permitted senders associated therewith;

under control of the recipient:

providing the sender information to a petition provider identified by the petition provider identifier;

accepting an access list petition request (petition) from the petition provider, said petition being stored in a computer readable storage medium;

determining whether the petition is acceptable based on at least one of: 1) a sender identity verification method; 2) user input; and 3) third party information; and

modifying said access list of permitted senders of the recipient such that the sender is added to said access list if the petition is determined to be acceptable; and

wherein the petition is created as a result of the sender receiving the recipient's email address; and

wherein the access list is used to determine whether email from the sender is permitted to reach the recipient.

As amended, Claim 1 defines a method for modifying lists used by email access control devices. This access list is modified by using a petition, which is created as a result of the sender receiving the recipient's email address (for example, at the time of subscription to a newsletter). Once the recipient receives a petition from a provider, it can determine whether that petition is acceptable and modify the access list by adding the sender to it. As such, Claim 1 features can make sure that the access list (e.g. address book and safe sender list) is updated reliably and automatically at the time that the recipient subscribes to a newsletter from the sender.

The features of Claim 1 address the problem of a recipient signing up for a newsletter and then having to remember to add the recipient's email address to their "white list" or "access list" (often implemented as the recipient's address book or safe sender list) to make sure the email gets delivered. Often a recipient will sign up for a newsletter and then neglect to update their list (which is done via the email program that may not be in use at the time of signing up). This can cause the sender's email messages to get filtered with spam control. The features of Claim 1 can allow the access list to be automatically and reliably updated so as to prevent such inconveniences.

Andivahis teaches a secure electronic messaging system requiring key retrieval for deriving decryption keys. More specifically, Andivahis appears to disclose a system of encrypting and decrypting email message transmission between several users by use of a key server (Andivahis, Abstract). Furthermore, Andivahis also appears to describe sender authentication during the message transmission (col. 16 line 57 – col. 17, line 24).

Shirai teaches an information processing system capable of file transmission and information processing apparatus in the system. More specifically, Shirai has been previously cited as teaching an access list for acceptable credentials.

However, Applicant respectfully submits that Andivahis and Shirai fail to disclose the features defined in Claim 1, as amended.

Firstly, the cited references fail to disclose modifying the access list of permitted senders of the recipient such that the sender is added to the access list if the petition is determined to be acceptable, as defined in amended Claim 1. Andivahis is not concerned with a method for modifying lists of permitted senders. Instead, Andivahis describes an access control device which checks sender authentication at the time that the email message is being sent (col. 16, line

57 – col. 17, line 24). Thus, rather than modifying any lists (as in Claim 1), Andivahis encrypts/decrypts messages and authenticates users during the actual message transmission.

Andivahis does include a way to check if the sender's account is current (col. 4, lines 46-64). However, this is entirely different from access lists used for spam control by ISPs and mail software, as defined in Claim 1. For example, in Claim 1, an access list is associated with a particular recipient and enumerates the permitted senders for that recipient, rather than merely specifying whether an account is valid. Furthermore, with access lists, general email from the entire internet must be received and delivered, not just a finite set of registered users, as disclosed in Andivahis.

Shirai, on the other hand, appears to describe an access list of users who are allowed to access a specific text file (see "users, masahiko, baba, and tokuko, are permitted to access file1.txt" col. 10, lines 60-65). These users who can access the text file are then designated as destination users when transmitting the text file. Thus, the text file is sent to the users who can access it. However, this is not the same as an access list that specifies whether the sender is permitted to send email to the sender, as defined in amended Claim 1. A list of users who can access a text file is different from an email access list which controls email reception. More importantly, neither reference discloses *modifying* the access list according to any petition, as defined in amended Claim 1.

Secondly, the references fail to disclose that the petition is created as the result of the sender receiving the recipient's email address, (such as in a subscription to a newsletter), as defined in amended Claim 1. This allows the verification of recipient's authority to update the access list by either the recipient directly or automatically by virtue of recipient credentials stored on the recipient's computer. None of this functionality is disclosed in Andivahis, since its main concern appears to be encryption/decryption of email messages. Similarly, Shirai also completely fails to disclose this feature of Claim 1.

Thirdly, the cited references fail to disclose an access list petition request that is defined in Claim 1, as amended. Andivahis teaches a public key request that is sent to the key server. Such a request for a public decryption key is not the same as a petition to update the recipient's access list, as defined in Claim 1. Similarly, Shirai also fails to mention any access list petition request, as defined in amended Claim 1.

In view of the above comments, Applicant respectfully submits that Claim 1, as amended, is neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

Claims 21, 40, 49, 50 and 60

Claims 21, 40, 49, 50 and 60, while independently patentable, recite limitations that, similarly to those described above with respect to claim 1, are not taught, suggested nor otherwise rendered obvious by the cited references. Reconsideration thereof is respectfully requested.

Claims 2-19, 22-38, 41-48 and 51-59

Claims 2-19, 22-38, 41-48 and 51-59 are not addressed separately, but it is respectfully submitted that these claims are allowable as depending from an allowable independent claim, and further in view of the comments provided above. Applicant respectfully submits that Claims 2-19, 22-38, 41-48 and 51-59 are similarly neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

It is also submitted that these claims also add their own limitations which render them patentable in their own right. Applicant respectfully reserves the right to argue these limitations should it become necessary in the future.

New Claims 66-70

The present Response hereby adds new Claims 66-70. Applicant respectfully submits that new Claims 66-70 are fully supported by the Specification as originally filed (e.g. par. [0030], [0048]-[0049]) and thus no new matter is being added. It is further submitted that new Claims 66-70 are patentable over the prior art references of record and consideration thereof is respectfully requested.

V.   Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration thereof is respectfully requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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